

REMARKS

1. The Examiner has rejected claims 1-6 under 35 U.S.C. §103(a) as being unpatentable over Irons, U.S. Patent No. 6, 192, 165 (hereinafter "Irons") and further in view of the publication "Xerox touts DataGlyphs for paper data" (hereinafter "Xerox"). The Applicant respectfully traverses the Examiner's rejection in view of the arguments presented in prior responses and for the reasons presented below.

The Applicant respectfully traverses the Examiner's rejection because a prima facie case of obviousness has not been established. MPEP 2143 enumerates three basic criteria that must be met to establish a prima facie case of obviousness. The first is that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine references teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference(s) must teach or suggest all the claimed limitations. The Applicant respectfully submits that the references themselves provide no motivation for combination and do not teach or suggest all the claimed limitations.

The Examiner has taken the position that "It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Xerox's signature verification within Iron's machine readable code, providing Irons the benefit of signature verification, since verifying the presence of handwritten signatures has a necessary bearing on the disposition of an invoice form. The Applicant respectfully submits that the system of Irons is directed to storage of a document image after it has already been determined

that it should be stored. This is described with respect to the flowchart of Figure 7 (in particular steps 710-750). The Applicant respectfully submits that Irons does not teach or suggest a need for determining the disposition of a form, since its disposition, e.g. that it should be stored, has already been determined. Further, the Applicant respectfully submits that it is the user who provides the information that is used to create the label. So to apply the signature verification of Xerox, the user must specify that it be performed. The Applicant respectfully fails to see a motivation for doing this as they had previously determined that the document should be stored. Thus, the Applicant respectfully submits that the system as described in Irons would derive no benefit from the signature verification from Xerox so there would be no suggestion or motivation to incorporate such a capability.

Further, the Applicant respectfully submits that the SmartPaper Controls of Xerox fails to teach or suggest a service to be performed on the image. The Applicant respectfully submits that the SmartPaper Controls are used for detecting or handling certain images on the document image itself and do not themselves identify a service that would be performed on the document image. Exemplary services are described in the specification in the paragraph spanning pages 7 and 8.

Accordingly, the Applicant respectfully submits that independent claim 1 fails to be taught or rendered obvious by Irons in view of Xerox, and the Applicant respectfully requests that the Examiner withdraw their 35 U.S.C. §103(a) rejection of independent claims 1.

The Applicant respectfully submits that dependent claims 2-6 depend on and incorporate the limitations of independent claim 1, which is distinguishable over Irons as

described above. Accordingly, the Applicant respectfully requests that the Examiner withdraw their 35 U.S.C. §103(a) rejection of dependent claims 2-6.

2. The Examiner has rejected claims 11, 14-15 under 35 U.S.C. §103(a) as being unpatentable over Irons, in view of Barton et al., U.S. Patent No. 5, 998, 752 (hereinafter Barton). The Applicant respectfully traverses the Examiner's rejection in view of the arguments presented in a previous response to office action, and further for the reasons presented below.

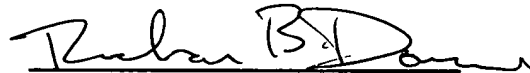
The Applicant respectfully submits that a prima facie case of obviousness has not been established since not all of the claim elements are taught in the cited prior art references. In response to the Applicant's prior argument, it is the Applicant's understanding that the Examiner has acknowledged that Barton's "routing code" does not itself define or describe a service. However, it is the Applicant's understanding that the Examiner is taking the position that "[s]ince said code is required for the service to be executed, said code acts to define said service by defining where to route said mail" (see last paragraph of page 9 of the office action). The Applicant respectfully submits that while such a code may be used by the service, it by itself does not define or describe the service. For example, a routing code may be used to suggest a part of a service (e.g. the routing portion of a route and fax or route and print service), it and of itself does not define or describe a service.

Accordingly, the Applicant respectfully requests that the Examiner withdraw their 35 U.S.C. §103(a) rejection of claims 11 and 14-15.

CONCLUSION

The Applicant respectfully submits that the foregoing amendments and arguments overcome the Examiner's various 35 U.S.C. §103(a) rejections and the Applicant respectfully respects that the Examiner grant allowance of all remaining pending claims.

Respectfully submitted,



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